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EXAMINER

BONSHOCK, DENNIS G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENISE MARIE GENTY, SHAWN PATRICK MULLEN,
JOHNNY MENG-HAN SHIEH, and JAMES STANLEY TESAURO

Appeal 2009-001824
Application 09/981,878¹
Technology Center 2100

Decided: March 16, 2010

Before JOHN A. JEFFERY, JAMES D. THOMAS, and JAY P. LUCAS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1, 4 to 6, 9 to 11, 14 to 16, and 19 to 29 under authority of 35 U.S.C. § 134(a). The Board of

¹ Application filed October 18, 2001. The real party in interest is International Business Machines Corporation.

Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 2, 3, 7, 8, 12, 13, 17, and 18 were canceled.

We affirm.

Appellants' invention relates to a method of bookmarking Web pages without opening a bookmark folder (Spec. 3, ll. 3-5). In the words of Appellants:

The invention uses a next and a previous icon to access the bookmarked web pages. When a Web page is being bookmarked, it can be chosen to be part of a route (i.e., a string of bookmarks to be successively accessed) or not. If it is part of a route, the bookmarked Web may be accessed without opening the bookmark folder by using either the next or the previous icon.

(Spec. 3, ll. 3-11).

Claim 1 and claim 29 are exemplary, and are reproduced below:

1. A method of accessing and displaying a plurality of bookmarked web pages, the plurality of bookmarked Web pages being arranged in a bookmark folder in a sequence in which the bookmarked Web pages are to be accessed, the method comprising the steps of:

activating a browser for a first time in a day, said browser, upon activation, having at least one icon associated with the first one of said bookmarked web pages in the sequence; and

asserting said at least one icon for accessing and displaying said first one of said bookmarked Web pages.

29. A method of bookmarking a plurality of web pages such that the plurality of the bookmarked web pages can be accessed without opening a bookmark folder in which the plurality of bookmarked web pages are stored comprising the steps of:

bookmarking the plurality of bookmarked Web pages by storing the plurality of bookmarked Web pages into the bookmark folder, the plurality of bookmarked Web pages being stored in the bookmark folder in a sequence in which the bookmarked Web pages are to be accessed;

enabling an icon in a browser to be associated with the first bookmarked Web page in the sequence;

enabling the icon upon being asserted to access and display the associated bookmarked Web page; and

allowing the icon to be asserted upon instantiation of the browser, the icon, after accessing and displaying an associated bookmarked Web page, is disassociated with the displayed bookmarked Web page and is associated with a next bookmarked Web page in the sequence.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Bauersfeld US 6,189,024 B1 Feb. 13, 2001
(filed on Jan. 06, 1998)

REJECTION

The Examiner rejects the claims as follows:

R1: Claims 1, 4 to 6, 9 to 11, 14 to 16, and 19 to 29 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Bauersfeld.

Appellants contend that the claimed subject matter is not anticipated by Bauersfeld because Appellants' claim limitation "activating a browser ..., said browser, upon activation, having at least one icon associated with the first one of said bookmarked web pages" is not taught by the references. (App. Br. 6, middle). The Examiner contends that each of the claims is properly rejected (Ans. 14, top).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants' Briefs. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue specifically turns on whether Bauersfeld anticipates Appellants' claim limitation "activating a browser ..., said browser, upon activation, having at least one icon associated with the first one of said bookmarked web pages." Specifically,

the issue is whether the claim precludes a user from making the association between the claimed “icon” and the claimed “first one of said bookmarked web pages.”

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method, program product, apparatus, and system of bookmarking Web pages without opening a bookmark folder (Spec. 3, ll. 3-5). When the browser is opened for the first time in a day, an icon is associated with the first in a sequence of bookmarked Web pages. Claim 1’s preamble recites a “method.” (*See* claim 1.)

Bauersfeld

2. The Bauersfeld reference teaches a method of bookmarking Web pages without opening a bookmark folder. (*See* col. 6, ll. 20-23.) In Bauersfeld, a user opens a browser for the first time in a day (*id.* at ll. 15-16). Bauersfeld further teaches that an icon in the browser is associated with the first in a sequence of bookmarked Web pages (*id.* at ll. 8-23).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” However, “[l]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *Zletz*, 893 F.2d at 321).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 3 to 9 of the Examiner’s Answer. In opposition, Appellants present two arguments.

*Arguments with respect to the rejection
of claims 1, 4 to 6, 9 to 11, 14 to 16, and 19 to 29
under 35 U.S.C. § 102(e) [R1]*

Appellants argue that Bauersfeld does not teach the steps of “activating,” “accessing,” and “displaying,” as recited in exemplary claim 1. Rather, Bauersfeld teaches that the user has to make the association by choosing a session file folder that contains a set of bookmarked Web pages or that the user has to begin to navigate through the Internet before the association occurs (App. Br. 6, middle).

In reply, the Examiner points out that the claim does not limit a user from making the association by choosing a session file folder.

We agree with the Examiner. We find that Appellants have invented a method, program product, apparatus, and system of bookmarking Web pages without opening a bookmark folder (FF#1). When the browser is opened for the first time in a day, an icon is associated with the first in a

sequence of bookmarked Web pages. In comparison, the Bauersfeld reference teaches a method of bookmarking Web pages without opening a bookmark folder. In Bauersfeld, a user opens a browser for the first time in a day. Bauersfeld further teaches that an icon in the browser is associated with the first in a sequence of bookmarked Web pages.

Our reviewing court states in *Zletz*, cited above, that “claims must be interpreted as broadly as their terms reasonably allow.” However, “[l]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, cited above).

We begin the analysis by noting that claim 1’s preamble merely recites a “method of accessing and displaying a plurality of bookmarked web pages.” (FF#1). The exemplary claim is not limited or restricted in such a way that a user could not have performed any of the claimed steps. (*See* claim 1.)² Appellants’ contention is that a user is required to make an association between a “Forward” button in Bauersfeld’s session file folder (App. Br. 6, middle), whereas the Specification does not disclose a user making such an association. However, in light of the lack of limitations on the “method,” we are not convinced by Appellants’ argument that a user is precluded. Although we read the claims in light of the Specification, we will not read any limitations into the claims. (*See Van Geuns*, cited above.) In this case, we do not read in the limitation that the “method” of claim 1 must exclude the actions of a user, because the claims do not recite that the “method” is limited or restricted in such a manner. Accordingly, we find no error.

² The method, as claimed, is not restricted or limited to, for example, a computer-implemented method (*id.*)

Claim 29 recites, in relevant part, “allowing the icon to be asserted upon instantiation of the browser, the icon, after accessing and displaying an associated bookmarked Web page, is disassociated with the displayed bookmarked Web page and is associated with a next bookmarked Web page in the sequence.”

Regarding exemplary claim 29, Appellants argue that because the Examiner made no finding regarding Appellants’ claim limitation “allowing the icon to be asserted upon instantiation of the browser,” the claim is allowable (App. Br. 7, middle).

We refer Appellants to the example cited in column 6 of the Bauersfeld reference. Bauersfeld teaches that a user who has a morning routine of checking a predetermined set of Web pages can traverse a set path. “Each path is plugged into the session history toolbar marking following a daily path as simple as hitting the back and forward button.” (Col. 6, ll. 17-19.) That is, Bauersfeld teaches that the user begins the routine by opening the pre-set path. Upon selecting the path (*e.g.*, “the morning routine” or “the lunch routine” at col. 6, ll 15-16), the forward button (Appellants’ claimed “icon”) allows the user to navigate the saved session path. (*See* Abstract.) “The user navigates through the saved session paths using a session history toolbar which allows the user to navigate through any selected session path and provides controls for backward, forward, pause, and record commands.” (*Id.*) We find that Bauersfeld’s forward button operates no differently from Appellants’ claimed “icon,” in that when the saved session path begins, the forward button is “asserted upon instantiation of the browser,” as claimed. The “allowing” step merely incorporates the claimed “sequence of Web pages” into the claim. The

“sequence,” as claimed, reads on Bauersfeld’s “saved session path” exemplified by the above-described “morning routine.” (*See* Abstract; *see, e.g.*, col. 6, ll 15-16.) Again, claim 29 is similar to claim 1, in that the preamble of claim 29 does not preclude a user from performing the method steps, as claimed. Accordingly, we find no error regarding the rejection [R1] of claim 29.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1, 4 to 6, 9 to 11, 14 to 16, and 19 to 29.

DECISION

The Examiner’s rejection [R1] of claims 1, 4 to 6, 9 to 11, 14 to 16, and 19 to 29 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

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